REMARKS

Claims 7 and 10-13 are pending in the present application. In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 7 and 10-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over German Patent Document No. DE 101 55 485 ("Barkowski") in view of U.S. Patent Application Publication No. 2002/0152022 ("Seto"). Claims 7 and 10-13 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0069360 ("Thoone") in view of Seto. Applicant respectfully submits that these obviousness rejections should be withdrawn for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed, and "obviousness cannot be sustained by mere conclusory statements." See KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). In addition, all the teachings of the prior art must be considered, including those which teach away from the claimed invention. (See M.P.E.P. 2143.01.II). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 7 has been amended to narrow the claim scope by reciting that "the useful data are enabled for an area defined by the user by <u>defining a center point and a radius of a circular region</u>." Seto merely suggests recording the "information on the size (coordinates on four corners of the road map data) of the delivered road map data (see, e.g., paragraph [0044]), but there is no suggestion in Seto that <u>the user is allowed to define the area for the useful data</u>, let alone defining the area for the useful data by <u>defining a center point and a radius of a circular region</u>. The only mention of user action found in Seto is the context of the statement that "the road map data of a specified size is . . . generated according to <u>operation inputs</u> by the user through operation input unit 12," (see, e.g., paragraph [0058]), but this statement clearly does not suggest anything about what the "operation inputs" are, let alone whether the user actually defines the boundaries of the road map data. Since the Examiner concedes that Barkowski and Thoone do not suggest "the useful data are enabled for an area defined by the user by <u>defining a center point and a radius of a circular region</u>," the applied combinations of references cannot render amended claim 7 obvious.

For at least the foregoing reasons, claim 7 and its dependent claims 10-13 are allowable over the combination of Barkowski and Seto, as well as over the combination of Thoone and Seto.

Independent of the above, dependent claim 11 has been amended to recite "<u>generating an error message and terminating a transmission of the useful data if navigation involves areas outside the user-defined area</u>," which feature is not disclosed or suggested by the combination of Barkowski and Seto, or by the combination of Thoone and Seto. In Barkowski, the map data is downloaded to the navigation apparatus and stored in a memory, but there is no suggestion of geography-dependent restriction of data transmission or associated error message. (See, e.g., Barkowski, paragraph [25]). Similarly, Thoone discusses a navigation system that checks to see if <u>the user is authorized</u> to access the roadmap data and restricts access if the user is not authorized, but Thoone does not disclose or suggest restricting data access if <u>navigation occurs outside a defined area</u>. (See Thoone, Paragraph [0009]). In addition, Seto does not contain any disclosure of the generation of an error message and the termination of the transmission of the useful data if a user moves outside a user-defined area. For at least these
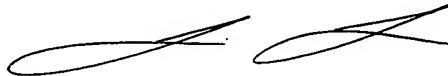
reasons, claim 11 is additionally allowable over the combination of Barkowski and Seto, as well as over the combination of Thoone and Seto.

CONCLUSION

In view of the above, it is respectfully submitted that all pending claims are allowable. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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_(R. No. 36,197)_

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